# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/755,934 | 01/04/2001 | Elliot Cooperstone | 37728-6048 | 3860 |

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| 7590          11/02/2005 | **EXAMINER** |
| Eileen A Lehmann | OUELLETTE, JONATHAN P |
| Fenwick & West LLP | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3629 | |

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DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | Application No. | Applicant(s) |
| --- | --- | --- | --- |
| ***Office Action Summary*** | | 09/755,934 | COOPERSTONE ET AL. |
| | | Examiner | Art Unit |
| | | Jonathan Ouellette | 3629 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *15 August 2005*.

2a)☒ This action is **FINAL.**      2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-13,17-29,31-36 and 38-58* is/are pending in the application.

    4a) Of the above claim(s) *1-8 and 43-50* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-13,17-29,31-36,38-42 and 51-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

# DETAILED ACTION

## *Response to Amendment*

1. Claims 14-16, 30, and 37 have been cancelled, Claims 52-58 have been added, and Claims 1-

8 and 43-50 have been withdrawn; therefore, Claims 9-13, 17-29, 31-36, 38-42, and 51-58

are currently pending in application 09/885,296.

## *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth
> in section 102 of this title, if the differences between the subject matter sought to be patented and the
> prior art are such that the subject matter as a whole would have been obvious at the time the invention
> was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability
> shall not be negatived by the manner in which the invention was made.

3. **Claims 9-13, 17-29, 31-36, 38-42, and 51-58 are rejected under 35 U.S.C. 103(a) as being**

**unpatentable over Kahn et al. (US 6,401,079).**

4. As per **independent Claims 9 and 21**, Kahn discloses a method of integrating a plurality of

human resource and employee benefit products, some of said products comprising a source

of data, said method comprising: (a) receiving a request from a requestor to conduct an

operation on said data of said plurality of products; (b) conducting said operation on a shared

data source (C13 L43-57, C26 L32-36); (c) initiating a plurality of tasks to perform said

operation for each of the plurality of products; determining which of said plurality of tasks

are critical and creating a sorted first list of all said tasks initiated to perform said operation

on the plurality of products that are determined to be critical (common rules for queuing

operation system commands); (e) synchronously executing said tasks from said first list,

wherein on said task is being executed at a time in order of priority, with a subsequent task

waiting for a previous task to complete (common rules for queuing operation system

commands); (f) determining which of said plurality of tasks are not critical and creating a

second list of all said tasks initiated to perform said operation on the plurality of products that

are determined to be non-critical (common rules for queuing operation system commands);

and (g) executing said tasks from said second list in asynchronous order (Abstract, Fig.5,

Figs.12(a)-15(e), Figs. 26-34(b), C5 L1-12, C5 L51-61, C13 L43-57, C26 L32-36, C52 39-

62).

5.  Kahn fails to expressly disclose wherein at least two of said products format said sources of

    data differently, and wherein same data regarding said operation to be performed is formatted

    to accommodate different formatting of each of said data source belonging to the plurality of

    products.

6.  However, Kahn does disclose seamlessly integrating employer data and third-party data to

    provide benefit information to system users (C52 L36-53).

7.  Therefore, it would have been obvious to one of ordinary skill in the art at the time the

    invention was made to have included wherein at least two of said products format said

    sources of data differently, and wherein same data regarding said operation to be performed

    is formatted to accommodate different formatting of each of said data source belonging to the

    plurality of products, in the system disclosed by Kahn, for the advantage of providing a

    method of integrating a plurality of human resource and employee benefit products, with the

ability to increase system efficiency by integrating information from a plurality of sources to

provide users with the most current/reliable information.

8.  As per Claims 10 and 22, Kahn discloses a step of initiating security lookup to determine

whether said request to conduct said operation is authorized and whether all of said plurality

of products are available to the requestor.

9.  As per Claims 11 and 23, Kahn discloses wherein if any one of said synchronously executed

tasks is not successfully completed all said synchronously executed tasks are rolled back.

10. As per Claims 12 and 24, Kahn discloses wherein said tasks from said second list are

executed by queuing and scheduling execution according to requirements of the products that

are determined to be non-critical and executing said tasks at a scheduled time.

11. As per Claims 13 and 25, Kahn discloses wherein said request to conduct said operation on

said data of said plurality of products is issued by a triggering event, said triggering event

comprising one or more events from among events in lives of employees, calendar events,

and predetermined events.

12. As per **independent Claim 17,** Kahn discloses a network site comprising a computer server

that provides display pages to requesting client machines, the network site further

comprising: (a) a first set of human resource and employee benefit products installed at the

computer server and accessed by a client machine; and (b) one or more network links from

the computer server to computer servers of corresponding third party providers, each of

whom offers one or more human resource and employee benefit products that are accessed

from a client machine by the network link, therein comprising a second set of human

resource and employee benefits products, wherein the computer server receives requests from

client users for services from the first and second set of human resource and the employee

benefit products, and responds by determining the appropriate application to process the

client user request, therein comprising an integrated benefits package accessed by the client

machines(Abstract, Fig.5, Figs.12(a)-15(e), Figs. 26-34(b), C5 L1-12, C5 L51-61, C13 L43-

57, C26 L32-36, C52 39-62).

13. Kahn fails to expressly disclose wherein the third party providers are bound to a determined

price and defined period of time for managing the links from the computer server.

14. However, Kahn does disclose maintaining a listing of providers and prices (c23 L40-57), and

it would have been obvious to one of ordinary skill in the art at the time the invention was

made to negotiate a contract with the providers before being entered as a listing in the

system, in order to maintain some data stability/consistency for system users.

15. As per Claim 18, Kahn discloses wherein the second set of the human resource and the

employee benefit products offered by the third party providers comprises one or more

applications from the set consisting of: retirement plans including *401K*; unemployment

insurance; Worker's compensation insurance; *group health insurance; dental insurance;*

*group life insurance*; disability insurance; employee assistance; tax filing services; and child

care services.

16. As per Claim 19, Kahn discloses wherein the first set of human resource and the employee

benefit products comprise: *payroll*; human resource compliance services; employee

development tools and advisory services; discount procurement; purchasing cards; and work

share and e-mail.

17. As per Claim 20, Kahn discloses wherein the computer server provides a user interface to an

authorized client user to modify the integrated benefits package, wherein the human resource

and the employee benefit products from said first set and the human resource and the

employee benefit products from said second set may be added and removed.

18. As per **independent Claim 26**, Kahn discloses a network computer server that manages and

administers a plurality of human resource and employee benefit products on a network, said

plurality of products being implemented on a plurality of network computing devices, the

server comprising: (a) a communication interface through which the server receives a user

request to perform data operations on data sources of said plurality of products; and (b) a

processor that conducts said data operations on the data sources of each of the plurality of

products; wherein said user views all of said plurality of products as residing on a single

computing device (Abstract, Fig.5, Figs.12(a)-15(e), Figs. 26-34(b), C5 L1-12, C5 L51-61,

C13 L43-57, C26 L32-36, C52 39-62).

19. Kahn fails to expressly disclose wherein said processor determines triggering events that

require actions on said data sources of each of said plurality of products and performs said

actions in an integrated fashion.

20. However, Kahn does the ability to update employee records (C27 L52-59), and issuing

system alerts to users (C52 L54-62).

21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to have included wherein said processor determines triggering events

that require actions on said data sources of each of said plurality of products and performs

said actions in an integrated fashion, in the system disclosed by Kahn, for the advantage of

providing a method of integrating a plurality of human resource and employee benefit

products, with the ability to increase system efficiency by allowing users to modify profile

information when appropriate.

22. As per Claim 27, Kahn discloses wherein the network is the Internet.

23. As per Claim 28, Kahn discloses wherein the processor responds to a user request in

accordance with a particular geographic location of the user residence.

24. As per **independent Claims 29 and 36**, Kahn discloses a method of processing operations in

an integrated human resource management system over a computer network, the method

comprising: determining if additional new employee information is needed to correctly

change affected data records and, if so, then eliciting the additional new employee

information from a system user; updating the determined affected data records in the data

store with the new employee information such that the updated data records are immediately

available to computer network processes of the human resource management system; and

responding to a request from one of the computer network processes by retrieving the

updated data records from the data store (Abstract, Fig.5, Figs.12(a)-15(e), Figs. 26-34(b),

C5 L1-12, C5 L51-61, C13 L43-57, C26 L32-36, C52 39-62).

25. Kahn fails to expressly disclose wherein said processor determines triggering events that

require actions on said data sources of each of said plurality of products and performs said

actions in an integrated fashion.

26. However, Kahn does the ability to update employee records (C27 L52-59), and issuing

system alerts to users (C52 L54-62).

27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to have included wherein said processor determines triggering events

that require actions on said data sources of each of said plurality of products and performs

said actions in an integrated fashion, in the system disclosed by Kahn, for the advantage of

providing a method of integrating a plurality of human resource and employee benefit

products, with the ability to increase system efficiency by allowing users to modify profile

information when appropriate.

28. As per Claims 31 and 38, Kahn discloses wherein the requesting network processes include

applications that are installed at a host network server that receives the requests, and includes

application that are installed at third party network servers that receive data requests from the

host network server.

29. As per Claims 32 and 39, Kahn discloses wherein the employee information data store

includes data record storage at the host network server and the data record storage located

remotely from the host network server.

30. As per Claims 33 and 40, Kahn discloses wherein the employee information data store

includes data record storage at the third party network servers.

31. As per Claims 34 and 41, Kahn discloses wherein the triggering event is an automatically

generated event.

32. As per Claims 35 and 42, Kahn discloses wherein the triggering event is an employee-

entered change to one of the data records.

33. As **per independent Claim 51**, Kahn discloses a user interface for displaying information

directed to a specific employee, the information relating to employee administration products

of an integrated package, the products including a third party provider product accessible

over a network, comprising: at least one link associates with the third party provider product

of the package; a first display area for displaying at least one recommendation relating to at

least one employee administration product (drop down box of available providers) of the

package responsive to receiving data (Abstract, Fig.5, Figs.12(a)-15(e), Figs. 26-34(b), C5

L1-12, C5 L51-61, C13 L43-57, C26 L32-36, C52 39-62).

34. Kahn fails to expressly disclose receiving data indicating entry into a time period for a life

event relating to the specific employee; and a second display area, separated from the first

display area by a boundary, for displaying at least one reminder for at least one product of the

package.

35. However, Kahn does the ability to update employee records (C27 L52-59), and issuing

system alerts to users (C52 L54-62).

36. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to have included receiving data indicating entry into a time period for a

life event relating to the specific employee; and a second display area, separated from the

first display area by a boundary, for displaying at least one reminder for at least one product

of the package, in the system disclosed by Kahn, for the advantage of providing a method of

integrating a plurality of human resource and employee benefit products, with the ability to

increase system efficiency by allowing users to modify profile information when appropriate.

37. As per **new independent Claims 52, 55, and 57**, Kahn discloses a method (system,

computer program product) of providing human resource and employee benefit products to a

client (abstract, employee), comprising: creating by an agent (employer) an integrated

package of human resource and employee benefit products selected from a plurality of

human resource and employee benefit products offered by a plurality of third-party service

providers (health, 401k, etc.), the integrated package including a human resource and

employee benefit products offered by at least one of the third-party service providers,

wherein the agent is independent of the client and the third-party service providers;

determining by the agent a price quotation for the integrated package (Figs.5-25, C5-C6,

C20-C28, C52, developing benefit plans and determining pricing using price listings); and

offering by the agent the integrated package at the determined price quotation to the client

via a computer network (C22 L30-43, employee selects benefits).

38. Kahn fails to expressly disclose wherein the price quotation being binding on each third-

party service provider providing the products in the integrated package.

39. However, Kahn does disclose maintaining a listing of providers and prices (C23 L40-57),

and it would have been obvious to one of ordinary skill in the art at the time the invention

was made to negotiate a contract with the providers before being entered as a listing in the

system, in order to maintain some data stability/consistency for system users.

40. As per new Claim 53, Kahn discloses wherein the integrated package further includes a

human resource and employee benefit product offered by the agent (employer).

41. As per new Claims 54, 56, and 58, Kahn discloses customizing the integrated package

according to an input received from the client via the network by adding or deleting a

specified human resource and employee benefit product to or from the integrated package,

the input describing a requirement for either a human resource product or an employee

benefit product (C52 L44-53).

### *Response to Arguments*

42. Applicant's arguments filed on 8/15/2005, with respect to Claims 9-13, 17-29, 31-36, 38-42, and 51-58, have been considered but are not persuasive. The rejection will remain as FINAL, base on the sited prior art.

43. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

44. The Applicant makes the argument that the prior art fails to disclose the ability of the system to determine which of a plurality of task are critical and which of the plurality of tasks are not critical, in order to prioritize the various tasks and to execute the tasks on each product in an organized fashion in accordance with task's relative importance (Claims 9-13 and 21-25).

45. However, such system usage prioritization was well known to one of ordinary skill at the time the invention was made as a common data handling structure within a computerized environment.

46. Furthermore, Kahn discloses the ability of the system to establish "workflow sequences' when handling system data (C13-C14), which automate the prioritization of workflows through the system.

47. The Applicant makes the argument that the prior art fails to disclose network links from the computer server to computer servers of corresponding third party providers, an integrated benefits package comprising one or more applications from the first and second set of human resource and employee benefits products, and wherein the network site binds third party providers to a determined price of their applications in the integrated benefits package (Claims 17-20).

48. However, Kahn discloses an integrated relationship between the employer and the third-party server provider, to include transferring of data and enables employers to provide personalized benefit plan options from which employees can select (C44 L1-25, C52 L44-53).

49. Furthermore, Kahn does disclose maintaining a listing of providers and prices (C23 L40-57, prices can be provided from the providers), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to negotiate a contract with the providers before being entered as a listing in the system, in order to maintain some data stability/consistency for system users.

50. The Applicant makes the argument that the prior art fails to disclose a network computer server that manages and administers a plurality of human resource and employee benefit products ... being implemented on a plurality of third party network computing devices, and a processor that performs actions on data sources according to a format of each plurality of products (Claim 26-28).

51. However, Kahn discloses a system for managing and administering a plurality of human

resource and employee benefit products (abstract, Figs.3-38), and discloses an integrated

relationship between the employer and the third-party server provider, to include transferring

of data and enables employers to provide personalized benefit plan options from which

employees can select (C44 L1-25, C52 L44-53).

52. Furthermore, Kahn discloses a computer system for handling benefit package creation and

selection, and creating rules and workflow sequences associated with the packages (benefits

and HR) (C13-C14, C26 L31-42)).

53. The Applicant makes the argument that the prior art fails to disclose converting the retrieved

updated data records into a data format that is compatible with the requesting network

process and providing the converted data records to the requesting network process (Claim

29, 31-36, and 38-42).

54. However, Kahn does disclose receiving benefit package updates from provider, which are

integrated into the HR/benefits system (C22 L30-42, security groups; C20 L16-20), and it

would have been obvious to one of ordinary skill in the art at the time the invention was

made to convert any data received into a compatible format with the system, in order to allow

the information to become an active part of the system.

55. Finally, the Applicant makes the argument that the prior art fails to disclose a first display

area for displaying at least one recommendation relating to the third party provider product of

the package and a second display area for displaying at least one reminder for the third party
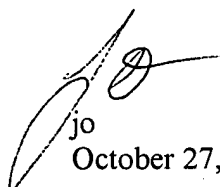
provider product of the package.

56. However, Kahn discloses the listing of available benefits (Health Carrier plans, Custom

health plans, 401k plans) for the employees through a first display (Fig. 12a, recommended

packages) and providing the employee with information regarding the available plans (C20

L46-57, C22 L30-42, C23 L40-57), and furthermore discloses issuing system alerts to users
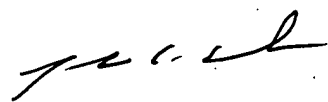
(C52 L54-62).

## *Conclusion*

57. Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The

examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

58. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization

where this application or proceeding is assigned (571) 273-8300 for all official

communications.

59. Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Office of Initial Patent Examination whose telephone number is

(703) 308-1202.

jo
October 27, 2005

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600